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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054683
Party	Defendant The Hispanic National Bar Foundation, Inc.
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Date	04/17/2015
Attachments	HNBF RESPONSE TO ORDER TO SHOW CAUSE.pdf(211864 bytes)


THE HISPANIC NATIONAL BAR ASSOCIATION, INC.,)	Cancellation No. 92054683
)	
Petitioner,)	Reg. Nos.: 3,443,817
)	3,447,638
v.)	
THE HISPANIC NATIONAL BAR FOUNDATION, INC.)	Marks: HNBF HISPANIC NATIONAL
)	BAR FOUNDATION and Design;
)	HNBF HISPANIC NATIONAL
)	BAR FOUNDATION IGUALDAD
)	A TRAVÉS DE LA EDUCACIÓN
Registrant.)	EQUALITY THROUGH
)	EDUCATION and Design

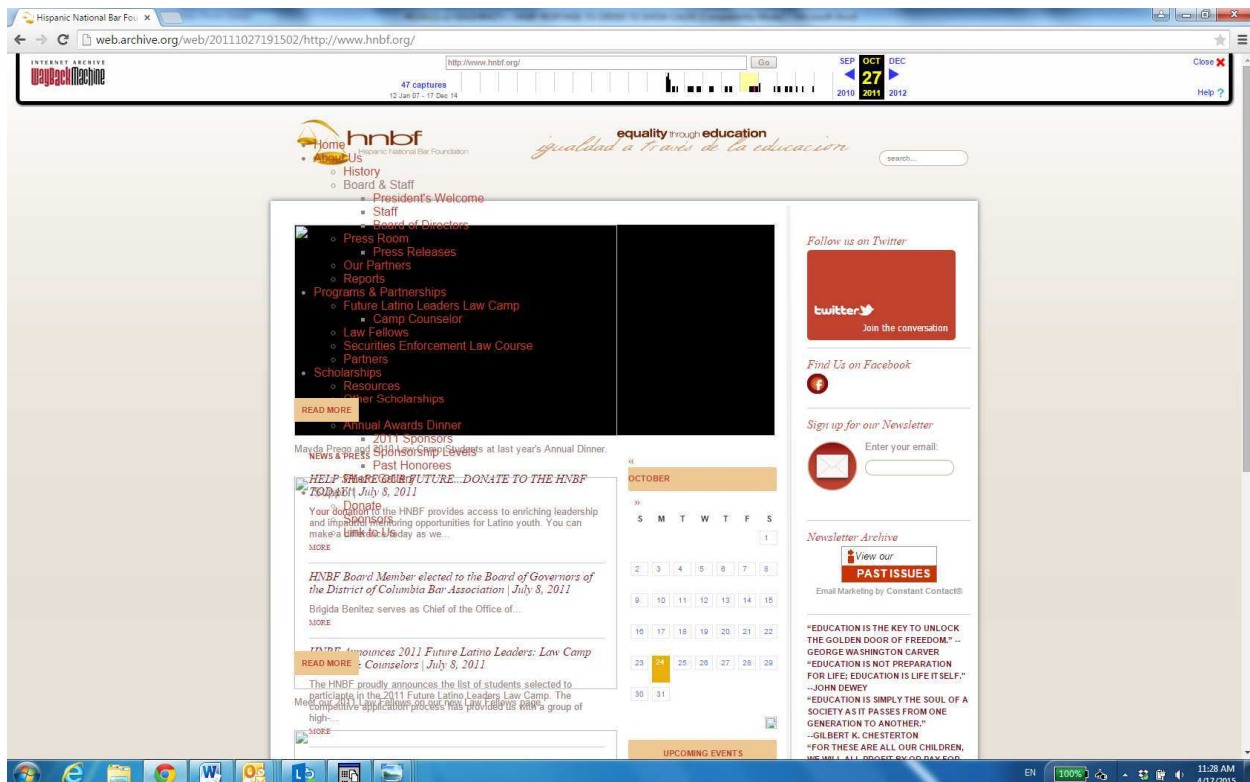
Registrant The Hispanic National Bar Foundation, Inc. (“HNBF” or “Registrant”) hereby submits this response to the Trademark Trial and Appeal Board’s (“Board’s”) order to show cause why cancellation of the registrations involved in this proceeding (“Registrations”) under Section 8 of the Trademark Act should not result in entry of judgment against Registrant as provided by Trademark Rule 2.134 (a). HNBF respectfully submits that because it permitted the Registrations to be cancelled under Trademark Act § 8 because the marks in the Registrations had been abandoned and the abandonment was not made for purposes of avoiding the proceeding, pursuant to 37 C.F.R. § 2.134 (b) and T.B.M.P. § 602.02(b), judgment should not be entered against Registrant on the grounds of likelihood of confusion.

Specifically, Petitioner filed the petition for cancellation on October 19, 2011 on the grounds of likelihood of confusion and filed an amended petition for cancellation on the grounds of likelihood of confusion and abandonment on May 19, 2014. The Registrations cover the marks depicted below:



Prior to October 19, 2011, the filing date of the petition for cancellation, HNBF made a deliberate business decision to change the overall branding of HNBF and had already begun

transitioning to a new HNBF & Design mark (). Indeed, as depicted in the screen shot from its website on October 27, 2011 obtained from archive.org (see upper left hand corner) below, HNBF had already begun making changes to its website to incorporate the new design in October of 2011:



By December 10, 2014, the grace period deadline for filing its Section 8 declaration of use, HNBF had fully completed its transition to the new HNBF & Design mark (although vestigial uses of the marks in the Registrations may continue to be available on press releases and earlier brochures and documents). As such, because the failure to file the Section 8 declaration of use was the result of a deliberate business decision made prior to commencement of the proceeding and not to avoid judgment, judgment should not be entered against HNBF on the ground of likelihood of confusion. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file Section 8 affidavit was result of deliberate business decision, judgment was not entered on the ground of likelihood of confusion). HNBF does not dispute that judgment may be entered against it on the ground of abandonment.

Respectfully submitted,

Dated: April 17, 2015

By: /AKS/

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing REGISTRANT THE HISPANIC NATIONAL BAR FOUNDATION, INC.'S RESPONSE TO ORDER TO SHOW CAUSE has been served via email to the following attorney of record for Petitioner:

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Dated: April 17, 2015

/AKS/

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